REMARKS/ARGUMENTS

Claims 1-12 remain in this application. Claims 13-20 have been withdrawn.

The examiner rejected claims 1-6, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,930,692 (Condon, Jr. et al.). The examiner rejected claims 7-9 and 12 under 35 U.S.C. §103 as being obvious in view of Condon, Jr. et al. Applicants respectfully traverse such rejections.

Independent claim 1 recites a thrust bearing comprising a first race component made of a first material and a second race component made of a second material that is more ductile than first material and including a flat portion in contact with the raceway portion of the first race component and, also, including a lip portion extending axially and radially from the flat portion and beyond the lip portion of the first race component such that the second race component is engageable by the bearing cage to hold the first race component, the second race component and the bearing cage together as an assembly.

The examiner acknowledges that Condon, Jr. et al. does not teach a thrust bearing with first and second race components made of different materials with one material being more ductile than the other material. The examiner than merely makes a conclusionary statement that it would be obvious to select materials suitable for an intended use. However, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. . . . To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." M.P.E.P. § 2142 *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Instead of providing objective evidence, the examiner makes the bald, conclusive statement that the reference teach some of the claimed elements and it would be obvious to modify the reference because the examiner believes, after reading appellants' application, that it would be obvious. The examiner's conclusive statement is based on hindsight, whereby the examiner has used the applicants' specification as a blue print to find the claims obvious.

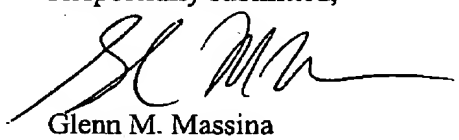
"However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. As the Federal Circuit recognized in In re Fritch 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

Since none of the cited references, alone or in any reasonable combination, teaches each and every one of the claimed limitations, the examiner has failed to establish a *prima facie* case of obviousness.

It is respectfully submitted that pending claims 1-12 are in condition for allowance. Early reconsideration and allowance of the pending claims are respectfully requested.

If the examiner believes an interview, either telephonic or in person, will advance the prosecution of this matter, it is respectfully requested that the examiner get in contact with the undersigned.

Respectfully submitted,



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